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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,279	10/17/2003	Baihua Wu	H0006498	9189

7590 07/19/2006

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EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,279

Applicant(s)

WU ET AL.

Examiner

Brian J. Davis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-147 is/are pending in the application.
- 4a) Of the above claim(s) 30-97, 106-121 and 128-147 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 98-105 and 122-127 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

112 Rejections Maintained

The rejection of claims 1-29, 98-105 and 122-127 under 35 USC 112, second paragraph, outlined in the previous Office Action, is maintained for reasons of record. Applicant's argument has been carefully considered, but is not persuasive.

Applicant argues that there is "essentially no difference between the terms 'compound' and 'composition.'" This is clearly false on point of fact. Applicant cites the Marriam-Webster Online Dictionary as evidence. However, this dictionary is merely a general English language dictionary - which is inappropriate as a reference for art-specific technical terms. The terms "compound" and "composition" are old, well-known and well-defined technical terms in the chemical arts with distinct and mutually exclusive meanings - as is evidenced by any one of a number of appropriate art-specific dictionaries (see, for instance, McGraw-Hill Dictionary of Chemical Terms, page 99; and in particular, Hawley's Condensed Chemical Dictionary 13th ed., page 291.)

The distinctness of the terms "compound" and "composition" is also reflected in the routine prosecution of patent applications in the chemical arts, for instance, in restriction practice, where claims to products (i.e. compounds) and claims to compositions are recognized as claims to distinct inventions (MPEP 802).

The examiner again notes for the record that for the purposes of the previous Office Action, and the instant Office Action, the instant claims have been examined with the reasonable assumption that they are drawn to a purified compound.

102 Rejections Maintained

The rejection of claims 1-29, 98-105 and 122-127, in so far as they read on applicant's elected species, under 35 USC 102(b), outlined in the previous Office Action, is maintained for reasons of record. Applicant's arguments have been carefully considered, but are not persuasive.

Applicant principally argues that the CPHA and its salts are not the invention. However, the claims, as written, are drawn to a purified form of an old and well-known compound, as was outlined in the previous Office Action. This fact, along with the pertinent case law, formed the basis of the rejection. Additionally, applicant's assertion that CPHA and its salts are not the invention seems in direct contradiction to applicant's previous election. That is, if CPHA and its salts are not the invention, how could one member of this set of compounds have been elected as the species used to begin prosecution?

The examiner respectfully submits that any patentable subject matter in the instant application will hinge directly on the clarification of the claims with respect to the terms "compound" and "composition" as outlined in the 112, second paragraph rejection of first Office Action, and maintained above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 **BRIAN DAVIS**
PRIMARY EXAMINER

Brian J. Davis
July 11, 2006